

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following remarks is respectfully requested.

A. **Status of the Claims and Explanation of Amendments**

Claims 1-32 are pending. By this paper, claims 1, 8, 14, 21 and 27 are amended to aid clarity. In each of these claims, an element had recited that it was "... adapted to send and receive alarm signals from the acceptor and from other acceptors, via the network...." This language was changed to "adapted to send alarm signals from the acceptor and receive alarm signals from other acceptors, via the network. Support for these amendments is found throughout the application as originally filed. It is respectfully asserted that no new matter will be added to this application by entry of these amendments.

As to the merits, claims 1-32 were found to be novel over the prior art. However, the pending office action rejected these claims pursuant to 35 U.S.C. § 103(a) as allegedly being unpatentable over Molbak in view of U.S. Patent No. 5,730,272 to Dobbins et al. ("Dobbins"). [6/15/05 Office Action at pp. 2-4].

B. **Claims 1-32 are Patentably Distinct from Molbak in view of Dobbins**

The rejection of claims 1-32 is respectfully traversed. As explained more fully below, the requirements for such rejections are not met.

Applicants' claim 1 recites:

1. An acceptor for money items or the like for use in a network of such acceptors, comprising:
sensing means for sensing parameters of an item submitted to the acceptor,
processing means for determining acceptability of the item submitted to the acceptor in the basis of an acceptance criteria using the parameters thereof sensed by the sensing means, and
communication means, associated with the processing means, and adapted to send alarm signals from the acceptor and receive alarm signals from other acceptors, via the network, wherein the processing means is configured to respond to a condition indicative of a fraud attempt by sending an alarm signal using said communication means and
wherein the processing means is configured to respond to an alarm signal, received by said communication means via the network, to modify the acceptance criteria.

1. Molbak Fails To Teach, Disclose Or Suggest
“Communication Means” As Recited in Applicants’ Claim 1

Molbak is directed to a coin acceptance method of receiving the contents of a coin hopper in a relatively short time period. Figures 18A and 18B are block diagrams of components of the control and I/O system, waste control system, and counting/sorting system. Figure 18A is shown below:

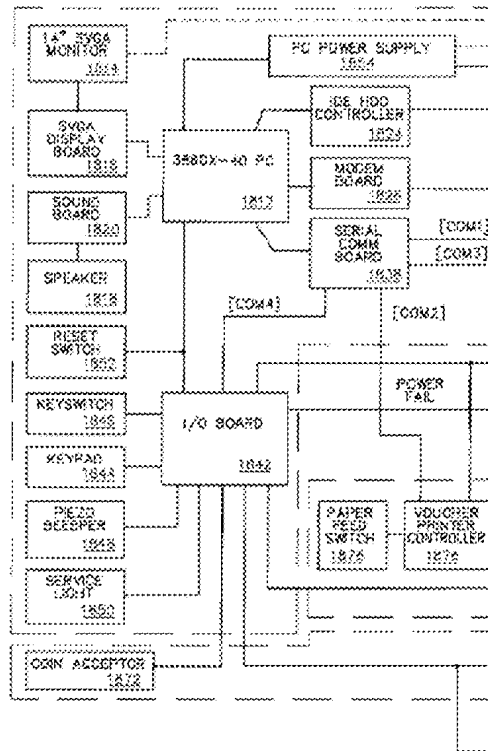


Fig. 18A

The office action alleges that Molbak's modem board (1826) and telephone line (1828) corresponds to the communication means in Applicants' claim 1. [6/15/06 Office Action at p. 2]. The office action admits that there is no correspondence between Molbak's coin acceptor (1872) and the sensing means and processing means in Applicants' claim 1. For that feature, the office action relies upon Dobbins.

In connection with Molbak, the office action argues that the alleged exchange of information between coin acceptor (1872) via modem (1826) equates to the communication means recited in Applicants' claim 1:

“Molbak discloses a central computing facility that communicates with many coin counters/sorters... The acceptor (1872) passes information from it to an I/O board (1842), to processor (1812), through modem (1826) and to a central computer facility.” [6/15/06 Office Action at p. 4].

There are several problems with this argument. First, Molbak does not teach, disclose or suggest communication between acceptors themselves, but rather between a coin-counting machine and a remote “central location.” Second, Molbak does not teach, disclose or suggest transmission or an alarm signal, but rather suggests that his modem may be used to exchange data such as changes in the types or values of coupons.

A reference numeral for the alleged central computer facility is not provided by the office action. Likewise, there was no specific reference in Molbak’s disclosure to support the Office Action’s allegation that “[t]he computer facility *can* in similar, but reverse fashion download information to said acceptor.” [6/15/06 Office Action at p. 4 (emphasis added)]. The use of the word “can” in the office action is an implicit admission that such disclosure is not actually present in Molbak.

Prima facie obviousness under 35 U.S.C. § 103 requires that the prior art would have led a person of ordinary skill in the art to make the claimed invention, with a reasonable expectation of success. See, e.g., In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1443 (Fed. Cir. 1991). “[O]bvious to try” is not the standard under § 103.” In re O’Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). “An ‘obvious-to-try’ situation exists when a general disclosure may pique the scientist’s curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure

itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued.” In re Eli Lilly & Co., 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Instead, the office action is apparently relying on an improper “obvious to try”-type rationale (i.e., the office action asserts that it would have been obvious to explore or modify a general approach disclosed in a cited reference, which only gives general guidance as to the particular form of the claimed invention in relevant part). For this deficiency alone, the office action has failed to establish a prima facie case of obviousness.

Another deficiency in the Office Action relates to the repeated references to a “central computer facility,” which apparently are intended to refer to the “central location” mentioned by Molbak. However, Molbak merely discloses routine uploading and downloading of information between a coin-counting machine and a “central location,” which is remote from and is not part of Molbak’s automatic coin-counting devices. Specifically, Molbak discloses that modem communication can be used for uploading or downloading data such as changes in the types or values of coupons to and from a remote “central location”:

“For example, changes in types or values of coupons to be dispensed can be downloaded from a central location. Information regarding the location of products within the store (e.g., for outputting a ‘shopping list’ format coupon or voucher, as described above) can be provided via the modem 1824, 1826.” [Molbak, Col. 12, lines 15-21].

Molbak discloses that the “central location” may comprise the offices of the

owner/ operator of the machine, a bank or an accounting firm:

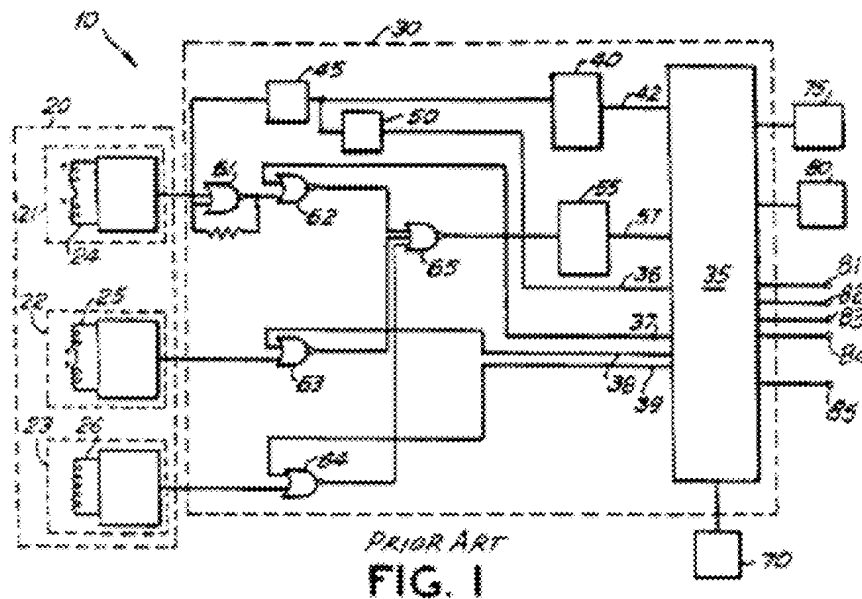
“In addition to accessing information by obtaining it directly at the site of the counting machine, the apparatus is also configured for providing information from the field location of the machine (or "remote location") to, for example, a central location such as offices of the owner/operator of the machine. Remote access can also be performed in connection with other entities such as a bank or an accounting firm. In one embodiment, the communication can be performed using a communication device such as modem board 1826. Communication can also be performed over a local area network system, over a wireless communication system (such as a wireless LAN or a cellular telephone communication system, or by a cable communication such as an interactive television or video communication system.” [Molbak, Col. 17, line 65 – Col. 8, line 5].

At best, Molbak suggests communication between an automatic coin-counting device and a “central location,” and does not contemplate communication between multiple automatic coin-counting devices themselves.

Molbak *does not disclose at any point* that its “central location” comprises a “central computer facility.” Molbak does not disclose means for, or means which could be adapted for, sending alarm signals between individual coin acceptors. Therefore, Molbak fails to teach, disclose or suggest “communication means, associated with the processing means, and adapted to send alarm signals from the acceptor and receive alarm signals from other acceptors, via the network” as recited in Applicants’ claim 1.

2. Molbak In Combination With Dobbins Fails To Teach, Disclose Or Suggest "Communication Means" As Recited in Applicants' Claim 1

The office action does not allege that Dobbins alleviates the above-referenced deficiency in Molbak. In particular, the office action alleges that Dobbins teaches an individual, isolated electronic coin testing apparatus (10) having a coin examining and sensing circuit (20) including individual sensor circuits (21, 22 and 23), and a processing and control circuit 30 as shown in Dobbin's Figure 1:



Dobbins describes that data from these circuits (21, 22, 23) is passed to the microprocessor (35), which in turn controls operation of this isolated electronic coin testing apparatus (10). Thus, Dobbins – like Molbak -- is completely silent regarding the exchange of data between isolated electronic coin testing apparatuses (10). Even assuming that Dobbins teaches what could constitute an alarm signal (and it does not),

there certainly is no disclosure that such an alarm signal is transmitted or received by other electronic coin testing apparatuses (10).

In sum, substitution of the sensing circuit (20) and microprocessor (35) of Dobbins for Molbak's coin acceptor (1872) would no produce "communication means, associated with the processing means, and adapted to send alarm signals from the acceptor and receive alarm signals from other acceptors, via the network" as recited in Applicants' claim 1. Accordingly, Applicants' claim 1 is believed to be patentably distinct from Molbak in view of Dobbins. For at least similar reasons, at least independent claims 8, 14, 21, and 27, and dependent claims 2-7, 9-13, 15-20, 22-26, and 28-32 also are believed to be patentably distinct from Molbak in view of Dobbins.

Applicants have chosen in the interest of expediting prosecution of this patent application to distinguish the cited documents from the pending claims as set forth above. These statements should not be regarded in any way as admissions that the cited documents are, in fact, prior art. Likewise, Applicants have chosen not to swear behind Molbak cited by the office action at this time. Applicant, however, reserves the right, as provided for under 37 C.F.R. § 1.131, to do so in the future as appropriate.

Finally, Applicants have not specifically addressed the rejections of the dependent claims. Applicants respectfully submit that the independent claims, from which they depend, are in condition for allowance as set forth above. Accordingly, the dependent claims also are in condition for allowance. Applicant, however, reserves the right to address such rejections of the dependent claims in the future as appropriate.

CONCLUSION

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. An early and favorable examination on the merits is requested. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED FOR THE TIMELY CONSIDERATION OF THIS AMENDMENT UNDER 37 C.F.R. §§ 1.16 AND 1.17, OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT NO. 13-4500, ORDER NO. 1193-4049.

Dated: September 5, 2006

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

By: *Matthew K. Blackburn*

Matthew K. Blackburn
Registration No. 47,428

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.

3 World Financial Center

New York, NY 10281-2101

(212) 415-8700

Telephone

(212) 415-8701

Facsimile